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| APPLICATION NO.                                                                                | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|------------------------------------------------------------------------------------------------|-------------|----------------------|---------------------|------------------|
| 09/668,296                                                                                     | 09/25/2000  | Makoto Hirahara      | HIRAHARA=1          | 1273             |
| 1444                                                                                           | 7590        | 06/15/2004           | EXAMINER            |                  |
| BROWDY AND NEIMARK, P.L.L.C.<br>624 NINTH STREET, NW<br>SUITE 300<br>WASHINGTON, DC 20001-5303 |             |                      | SHAFFER, ERIC T     |                  |
|                                                                                                |             |                      | ART UNIT            | PAPER NUMBER     |
|                                                                                                |             |                      | 3623                |                  |

DATE MAILED: 06/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |    |
|------------------------------|------------------------|---------------------|----|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |    |
|                              | 09/668,296             | HIRAHARA ET AL.     |    |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |    |
|                              | Eric T. Shaffer        | 3623                | MW |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 03 March 2004.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 27 - 44 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 27 - 44 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 25 September 2000 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

|                                                                                                       |                                                                              |
|-------------------------------------------------------------------------------------------------------|------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                      | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6 . | 6) <input type="checkbox"/> Other: _____ .                                   |

**DETAILED ACTION**

1. The following is an initial Office Action upon examination of the above-identified application on the merits. Claims 27 - 44 are pending in this application.

***Summary of Instant Office Action***

2. Applicant's amendment, filed March 3, 2004, concerning claims 1 - 44, have been considered and deemed unpersuasive.

3. The applicant has cancelled claims 1 – 26 and the applicant has added new claims 27 - 44. Claims 27 - 44 are pending and prosecuted in the response set out below.

***Claim Rejections - 35 USC § 112***

4. Claim 27 – 44 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant uses the term “relationships among the members of the group” in the claim language without providing a description in the specifications.

***Claim Rejections - 35 USC § 101***

5. Claims 27 - 44 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e. abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, invoke, use, or advance the technological arts.

In the present case, the method claims of visiting plan generation method that receives inputting of information and stores information, does not specifically use a computer or computer operable medium. Specifically, claims 27 - 44 do not affect, effect, or are affected by technology, and thus do not recite statutory subject matter.

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 27 - 44 are deemed to be directed to non-statutory subject matter.

#### *Response to Amendments*

6. Applicant's arguments filed March 3, 2004, have been fully considered, but the same are not persuasive.

a) Applicant argues that receiving input information teaches technology sufficient to overcome a rejection under 35 U.S.C. 101. However, mere input of information into a system is passive. Unless the system process the data in some way, the input of data is a nominal recitation of technology. Incorporation of technology sufficient to overcome a rejection under 35 USC 101 is not taught merely by the input of information.

b) Applicant argues that storing state information is sufficient to overcome a rejection under 35 U.S.C. 101. However, mere input of information into a system is passive. Information can be stored by writing the data down on paper and storing the paper without the use of technology. Unless the system processes the data in some way, the input of data is a nominal recitation of technology. Incorporation of technology sufficient to overcome a rejection under 35 USC 101 is not taught merely by the storing of information.

c) Applicant requests clarification of the rejection under 35 USC 102(e). This is a typographical error and the rejection is under 35 USC 103(a) as stated in the heading "Claim Rejections – 35 USC 103" and defined in the "quotation from 35 USC 103(a)" in the beginning of the action.

***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

ETS

June 9, 2004